

REMARKS/ARGUMENTS

Status of the Application

As filed, this application included claims 1-33. A first office action mailed March 29, 2004 rejected claims 1-33 under 35 U.S.C. § 112, ¶ 2 as indefinite and as being incomplete for omitting essential steps or elements. The office action also rejected claim 1-23 under 35 U.S.C. § 101 as directed toward non-statutory subject matter. Claims 1, 2, 5, 6, 8-14, 21-25, 27 and 32 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,298,327 ("Hunter"), claims 28 and 29 stand rejected under § 103(a) as unpatentable over Hunter, claims 4, 15, 17-20 and 30 and 33 stand rejected under § 103(a) as unpatentable over Hunter in view of U.S. Patent No. 6,434,580 ("Takano"), claims 7, 16 and 31 stand rejected under § 103(a) as unpatentable over Hunter in view of U.S. Pub. App. No. 2001/0049797 ("Tran"), and claims 3 and 26 stand rejected under § 103(a) as unpatentable over Hunter in view of U.S. Pub. App. No. 2001/0037460 ("Porcari"). This amendment amends claims 3, 8 and 24 and adds new claims 34-44. No claims have been canceled. Hence, after entry of this amendment, claims 1-33 will remain pending in the application.

Claim Amendments

Claims 3, 8 and 24 have been amended. Claims 3 and 24 have been amended to correct a typographical errors, and claim 8 has been amended to recited that "the prompt comprises a field in a mouse pop-up menu." Support for the amendment to claim 8 may be found, *inter alia*, at lines 2-26 on page 8 of the application. New claims 34-44 have been added. Support for these new claims can be found, *inter alia*, in original claims 13, 14 and 16-23.

Rejections under 35 U.S.C. § 112

The office action rejected all pending claims under § 112, ¶ 2 as being indefinite and as omitting essential steps. The applicant traverses these rejections in part and submits that the rejections have been overcome in part. With respect to the office action's rejection of the term "field in a mouse pop up window," the applicant submits that the amendments to claim 8 and 24 overcomes this rejections. Applicant further submits that the office action's objection to

the term “IDS information” is unfounded; to the extent this term is unclear on its face (a proposition the applicant disputes), the specification (*e.g.*, at lines 18-19 on page 5 of the application) clearly supplies sufficient meaning to allow one skilled in the art to ascertain what is being claimed. *See* MPEP § 2106 (“Office personnel must rely on the applicant’s disclosure to properly determine the meaning of terms used in the claims.” (citing *Markman v. Westview Instruments*, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir. 1996) (*en banc*))).

Regarding the objection to the term “signal,” the Applicant respectfully disagrees that the term is indefinite. The specification (*e.g.*, p. 8, l. 24 – p. 9, l. 10 and p. 13, ll. 18-19) describes several exemplary signals that may be used in accordance with various embodiments of the invention. While these examples are not exhaustive of the universe of signals that may be used in all embodiments of the invention, they certainly are sufficient to convey to one of skill in the art what is meant by the term “signal,” as it is used in the claims.

The office action also rejects as indefinite the term “automatically,” as it is used in the claims. The applicant respectfully disagrees and submits that those skilled in the art, having the benefit of the application’s specification, would easily be able to ascertain the meaning of the term “automatically,” as it is used in the claims. For example, one dictionary defines the term “automatic” as “[a]cting or operating in a manner essentially independent of external influence or control.” (American Heritage Dictionary of the English Language, 4th ed. (2000), *see* <<http://dictionary.reference.com/search?q=automatically>>), and the term “automatically” is merely the adverbial form of the adjective “automatic.” Thus, the term “automatically,” as used in the claims, can indicate that the described procedures can be performed without external influence (*e.g.*, user input).

Likewise, the term “electronic button” is familiar to those skilled in the art. Merely by way of example, one dictionary defines the term “button,” as it is used in computer science, to mean “[i]n graphical user interface systems, a well-defined area within the interface that is clicked to select a command.” (American Heritage Dictionary of the English Language, 4th ed. (2000), *see* <<http://dictionary.reference.com/search?q=button>>). The term “electronic” is merely a modifier indicating that the term “button” is used in its common sense as understood in the relevant field (*i.e.*, computer software).

The applicant also traverses the rejection of the claims as omitting essential steps or elements. Section 2172.01 of the MPEP, cited by the Examiner, states merely that “[a] claim which omits matter disclosed to be essential to the invention as described in the specification or other statements of record may be rejected under 35 U.S.C. [§] 112, first paragraph, as not enabling.” The office action points to nothing in the record that indicates that any steps or elements disclosed by the specification as essential to the invention are not included in the claims. In fact, each of the § 112, ¶ 2 rejections pertains to elements that are claimed. Moreover, each of these steps or elements are described in detail in the specification. It is difficult to understand, therefore, why these elements have been rejected under MPEP § 2172.01, and the applicant respectfully requests that the rejections be withdrawn.

Rejections under 35 U.S.C. § 101

The office action rejects claims 1-23 under § 101 as being directed to non-statutory subject matter. Despite the fact that claim 1, from which all other rejected claims depend, recites “a computer-implemented method,” the office action asserts that there is nothing “in the claim as a whole to breathe life and meaning into the preamble,” and therefore that the term “computer-implemented” provides no basis in the technological arts for the claim. The applicant traverses this rejection and respectfully submits that the Examiner misperceives the relevant test. As the Federal Circuit has stated, a “term appearing in preamble is a ‘necessary limitation’ where the term ‘breathes life and meaning into the claims.’” *In re Gold*, 29 F.3d 644 (table) (unpublished) (quoting *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 866, 228 USPQ 90, 92 (Fed. Cir. 1985)) (emphasis added). Thus, it is the term at issue which must breathe life into the claim, not the converse. In this case, the term “computer-implemented” certainly breathes life and meaning into the claims: It indicates that the method, as claimed, is implemented (at least in part) by a computer.

The office action, however, asserts that the term “computer-implemented” merely indicates an intended use. It is submitted that this interpretation is incorrect. The term “computer-implemented” does not indicate merely a purpose for which the method of claim 1 is to be used. Instead, it indicates a structural apparatus that is to be used to perform at least some

of the procedures recited in claim 1. As such, the term “computer-implemented” provides a sufficient basis in the technological arts to meet the requirements of § 101. Claim 1, therefore, is directed toward statutory subject matter (as are claims 2-23, which depend therefrom), and the applicant respectfully requests that the rejections under § 101 be withdrawn.

Rejections under 35 U.S.C. §§ 102, 103

The office action rejects claims 1, 2, 5, 6, 8-14, 21-25, 27 and 32 under § 102(e) as anticipated by Hunter, and the remaining claims under § 103(a) as unpatentable over Hunter, either alone or in combinations with various other references. The applicant respectfully traverses these rejections and submits the following argument in support of his position. Merely by way of example, claim 1 recites, *inter alia*, “associating the IDS information with an electronic information disclosure statement.” As the Examiner surely is aware, the term “information disclosure statement” is well known in the art to describe a particular type of document used to submit prior art references (and other information) to the USPTO for consideration by an examiner. Nothing in the disclosure of Hunter even contemplates an electronic information disclosure statement (in fact, neither the term “information disclosure statement” or “IDS” or even appears in Hunter’s disclosure). In contrast, Hunter (c. 2, ll. 43-47) is directed to a system that allows “inventors to adequately disclose (communicate) the characteristics of their inventions to their technology manager and research sponsor, as well as to their patent professional (*i.e.*, patent attorney or patent agent.” Basically, then, Hunter’s invention functions to identify and categorize new inventions, and perhaps assist in the preparation of a patent application—it has nothing to do with electronic information disclosure statements.

While Hunter (c. 3, ll. 53-66, c. 17, ll. 3-7) does note that its system can allow a user to note any prior art, for the purpose of comparing the invention to the prior art, the office action fails to cite (and the applicant cannot find) anything in Hunter that indicates that this information might be associated with an electronic IDS. Nor does Hunter provide any suggestion or motivation to indicate that it might be modified to include this functionality. Thus,

Hunter fails either to disclose or suggest the limitations of claim 1; claim 1, therefore, is allowable over Hunter. For similar reasons, claim 24 is allowable over Hunter.

Claims 2-23 and 25-33 (as well as new claims 34-44) are allowable over Hunter as depending from allowable base claims and as being directed to specific novel substitutes. For example, the office action rejects claims 5 and 27 under § 102(e), and claims 28 and 29 under § 103(a), all as unpatentable over Hunter. Claim 27, which is exemplary, recites, *inter alia*, “computer instructions to extract the IDS information from the reference information.” The cited portion of Hunter (c. 17, ll. 3-7) merely defines prior art, and in so doing, fails even to mention any distinction between “reference information” and “IDS information,” as those terms are used in this application. Moreover, Hunter nowhere mentions that IDS information might be extracted from reference information, or discusses any information about prior art other than its “content.” Clearly, Hunter fails to anticipate either claim 5 or claim 27.

With respect to claims 28 and 29, the office action purports to take official notice “that it is old and well known to extract information with one mouse click and it is old and well known to extract information by parsing information.” The applicant respectfully traverses this official notice and requests that the Examiner cite a reference disclosing such information.

Nor do any of the other references cited in the office action remedy Hunter’s deficiencies. It should be noted at the outset that both Porcari and Tran were filed after the present application. While each includes a priority claim that predates the filing date of this application, Tran is a conversion of a provisional application, and Porcari is a continuation-in-part. It is likely that the disclosures of the respective priority applications differ from those of the applications cited in the office action, and the cited references thus may not even qualify as prior art to the present application. The applicant, therefore, reserves the right to challenge the asserted priority dates of the Tran and Porcari references. Assuming, *arguendo*, that the cited applications do qualify as prior art, however, none of them discloses or suggests even the limitations of independent claim 1, let alone the other claims in this application.

While Tran (para. 0044), for example, mentions in passing that “[t]he process 200 also generates an information disclosure statement (IDS) based on the known prior art (step 220),” Tran fails to disclose any of the elements of claim 1, including “associating the IDS

information with an electronic disclosure statement.” Similarly, while Porcari (para. 0056) purports “anticipate[] a method Information Disclosure Statement in XML form that contains hyperlinks to identified documents,” the reference does not provide any explanation of what this statement means, and it fails to disclose either “receiving a signal indicating that a user has identified an electronic document that contains reference information to be disclosed to a patent office” or “associating the IDS information with an electronic information disclosure statement.” Moreover, neither of the one-sentence “disclosures” of Tran and Porcari could remotely be considered sufficiently enabling to constitute a disclosure of the invention claimed in this application. Finally, Takano, like Hunter, fails even to mention the terms “information disclosure statement” or “IDS.” Instead, Takano is directed to a system for drafting patent specifications. It has nothing to do with the generation of an IDS.


For at least these reasons, claims 1-33 are allowable over Hunter, taken either alone or in combination with the cited references. The applicant, therefore, respectfully requests that the rejections under §§ 102 and 103 be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,


Chad E. King
Reg. No. 44,187

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 303-571-4321
CEK:tnd
60197376 v1